

Remarks

Specification

Paragraph [0004] of the specification is amended as follows to recite that the term pipe branch at its first occurrence means pipe bifurcation,

[0004] This object is attained by a muffler device of a motor vehicle comprising a plurality of mufflers, and an actuator for changing a flow resistance of exhaust gases flowing through the mufflers to change the damping characteristic of the muffler device, wherein the actuator is provided in a pipe branch (i.e. pipe bifurcation) comprising an inlet and a plurality of outlets, each outlet being connected by a pipe connecting to one of the mufflers, and a throughflow cross section of the inlet being variable by means of the actuator.

Claim Rejections 35 USC 112

In response to the "112" rejections the term substantially has been deleted from the claims 28, 29, and 54.

A period has been added at the end of claim 48.

Claim Rejections 35 USC 102

Claims 23-26, 28, 29, 35-37, 40, 51, 52, 54, 55 and 60-62 were rejected as being anticipated by Tadokoro et al. (Tadokoro).

Valid rejection under 35 USC 102 requires that each feature of a rejected claim be disclosed in a single reference. "For anticipation under 35 USC 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." MPEP 706.02(a)

Tadokoro does not disclose each feature of the rejected claims.

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The "102" rejection on Tadokoro on independent claim 23 is based on a misconception of the term "pipe branch" in our claim 23. The corresponding reference numeral 5 in Applicant's Figures makes it clear that the term "pipe branch" within the meaning of applicant's independent claim 23 means "pipe bifurcation" or "pipe branching". In this respect it should be noted, that the corresponding German expression "Strömungsverzweigung" in the German priority application 100 20 491.0 can also be translated as "flow (pipe) branching" or "flow (pipe) bifurcation".

The pipe bifurcation of Figure 1 of Tadokoro obviously is where the exhaust passageway 21 bifurcates into the first branch exhaust passageway 21A and the second branch exhaust passageway 21B. So, unlike our actuator, which is provided directly at the pipe bifurcation, in Tadokoro neither the actuator 26, which operates on the shift valve 25, nor the shift valve 25 itself is located at the pipe bifurcation. Instead, they are located at or respectively in the first branch exhaust passageway 21A that is in one of the "connecting pipes" using the term of our claims. This is very explicitly stated in column 5, line 48 to column 6, line 7 of Tadokoro.

A further difference to claim 23 is that the shift valve 25 of Tadokoro can only change the throughflow cross section of the first branch exhaust passageway 21A, that is one of the "connecting pipes", but not the throughflow cross section of the inlet of the pipe bifurcation, according to our claims.

Claim Rejections 35 USC 103

Claims 34 and 49 were rejected as being unpatentable over Tadokoro in view of Fallon.

Tadokoro and Fallon do not motivate or suggest to a person skilled in the art to combine these references to duplicate the claims of the present invention.

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Neither Tadokoro nor any of the cited references discloses an actuator provided in a pipe bifurcation for changing the throughflow cross section of the inlet of the pipe bifurcation

Valid rejection under 35 USC 103(a) requires evidence of a suggestion or motivation for one skilled in the art to combine prior art references to produce the claimed invention. US Court of Appeals for the Federal Circuit (*Ecolchem inc. v Southern California Edison Co., Fed. Cir.*, No. 99/1043, 9/7/00).

The best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for showing a teaching or motivation to combine the prior art references, according to the court.

Recently, in *In Re Sang-Su Lee* (00-1158) the Court of Appeals for the Federal Circuit rendered a decision confirming the above principles. The court analyzed 35 USC 103 requirements starting from the Administrative Procedure Act and held (citations omitted):

“Tribunals of the PTO are governed by the Administrative Procedure Act, and their rulings receive the same judicial deference as do tribunals of other administrative agencies.

“The Administrative Procedure Act, which governs the proceedings of administrative agencies and related judicial review, establishes a scheme of “reasoned decision making.”

Not only must an agency’s decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational.

“As applied to the determination of patentability vel non when the issue is obviousness, it is fundamental that rejections under 35 USC §103 must be based on evidence comprehended by the language of that section. (Emphasis added). When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding

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of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. (Emphasis added)

"The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. There must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant. Teachings of references can be combined only if there is some suggestion or incentive to do so."

As stated above Tadokoro or Fallon do not motivate or suggest to one skilled in the art to combine these references to produce Applicant's claimed invention.

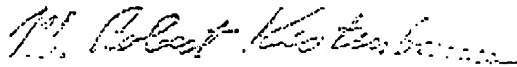
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We respectfully request that the Examiner give further consideration to the claims as now amended and allow them.

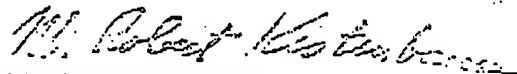
A three-month extension of time in which to respond to the outstanding Office Action is hereby requested. PTO-2038 authorizing credit card payment for the amount of \$950 is enclosed for the prescribed Large Entity three-month extension fee. Please charge any additional fees or credit any overpayments to Deposit Account 11-0665. A duplicate of this page is enclosed for this purpose.

Respectfully submitted,



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I hereby certify this correspondence is being submitted to Commissioner for Patents, Alexandria, VA 22313-1450 by facsimile transmission on October 25, 2003, fax number (703) 872 9318



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